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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,112	06/13/2000	Theresa M Gosko	M-8811	7080
33438	7590	08/23/2004	EXAMINER	
HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/593,112

Applicant(s)

GOSKO, THERESA M

Examiner

Matthew s Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-30 rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. U.S. Patent No. 5,319,542 in view of the article "Come, and they will build it" (Geller, Scott. June 1999. *Manufacturing Systems*).**

King et al. discloses a system that facilitates a user in electronically ordering items from suppliers. Suppliers manage their own supplier master catalog [Figure 1, Element 106]. Customers can maintain access to their own version of the supplier master catalog" [Col 4, Line 15. Figure 1, Element 1 10] (presenting a data file, including a catalog, to a purchaser). The Private catalog can reside on a customer's host computer system or on a public network and can be maintained by customers or suppliers [Col 4, Line 31] (presenting includes transmitting the data file to the customer

Art Unit: 3625

or hosting the data file on a world wide web interface - public network). Customers can store catalog items in their private catalogs such as volume purchase agreements, corporate contract discounts, control items, etc. [Col 4, Line 23] (data file includes business rules in a structured data format, data file includes pricing according to predetermined agreements with the manufacturer and the host). Private catalogs are obtained from direct input from the supplier database or are created by the customer [Col 4, Line 27]. Information is transmitted to the customer using Electronic Data Interchange [Col 5, Line 25] (data file is an EDI format). Suppliers can issue separate batch transaction commands modifying unit prices, discounts, payment terms, usage fees, etc. [Col 5, Line 24] (transmitting an action code within the data file denoting product configurations requiring replacement in a procurement system). A customer can order directly from the private catalog, since the source of the catalog item has been pre-approved [Col 5, Line 50] (the data file is configured to be incorporated into a procurement system).

In specific reference to claims 1 and 7, King et al. does not explicitly disclose that the catalog is one of configurable products including at least one of non-commodity products and services.

Geller discloses that configurators "have been around for more than 20 years." Geller discloses the widespread use of different types of configurators in electronic catalogs including:

Art Unit: 3625

- Features and options configurators in which the end user selects one option from each feature group attached to the product being configured. The part number associated with the selected option is added to the configured product.
- Rule-based configurators which encompass 1) reading the rules 2) determining the implied dependencies between the rules 2) working forward from inputs towards the goal 4) prompting the user for inputs as needed to continue processing. The configurator's interface typically displays a series of questions, one at a time, in a sequence determined by the engine.
- Object-oriented configurators which are ideal for configuring a system wherein the number of components is potentially large and cannot be known until the end-user is actually doing the configurations as opposed to the time the designer is programming the configurator.
- Constraint-based configurators incorporating object-oriented programming principle known as inheritance. From an end-user perspective, it looks like the familiar shopping cart metaphor used on the Internet. The user selects products from a catalog on one side of the screen to a shopping cart on the other. As the products are selected other products in the catalog are highlighted as required or excluded.

Configurators inherently comprise acknowledgement and notification of acceptable/unacceptable product configuration. It is established that configurators are widely known in the art of electronic shopping and catalog deployment. King et al. discloses a system that allows users to download "private" catalogs, direct from the manufacturer, to their client-side computers. It would have been obvious to modify the system of King et al. to allow users to download any type of catalog, with configuring capability - as taught by Geller - or otherwise, in order to facilitate customers in finding the most appropriate product or service (Geller, Pg. 1).

In specific reference to claims 2 and 3 the system of King et al. and Geller does not explicitly provide that:

- The purchaser includes at least one of a customer, a third party acting on behalf of the customer and a supplier

Art Unit: 3625

- The manufacturer includes a third party acting on behalf of the manufacturer

It would have been obvious to one of ordinary skill in the art to allow any number of parties to participate in the system of King/Geller. The specific party acting, whether the customer, manufacturer or a representative thereof would have been recognized by the skilled artisan as being one of numerous parties suitable for conducting business within the system. The applicant has not persuasively demonstrated that the specific party is anything more than one of the numerous ones that a skilled artisan would have found suitable for the purpose taught by King/Geller. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow any number of parties, generally taught as supplier or customer in the system of King/Geller, to participate in the distributed catalog system. Further it is inherent that the private catalog is accessed at the customer's computer (configuration of products independent of a third party provided configuration tool - the catalog is provided directly from the manufacturer and accessed at the customer's computer without third-party intervention).

In specific reference to claims 8, 9, 14, 16 -20, the system of King et al. and Geller does not explicitly provide for a catalog that:

- Includes manipulability parameters that enable configuration of non-commodity products or services, where manipulable parameters include upgrades, downgrades and swapping of components
- Includes non-manipulable parameters that contribute to the configuration of a non-commodity product or service including parent components, orphan components, child components, configuration components and optional components

Art Unit: 3625

- Includes a configuration identifier, a price of the configuration, type of components, custom or bundled, upgrades, downgrades and additions permitted with pricing, work flow data identifying add configurations, discontinue configuration, replace configuration, effective data and discontinue data
- Includes at least one of factory-installed components, non-factory installed components, and subsystem configurations - where factory installed, non-factory installed, customer kit and solution data includes the associated Stock Keeping Units (SKUS, including a third parties or a manufacturer generated SKUS and pricing)
- Includes a core configuration including commodity and non-commodity default services and customer-specific integration components - where integration components can include customer specific software, menus, images, asset tag labels, security cables, transportation industry options and transportation services

The type of data being stored by the configurator or catalog is merely descriptive non-functional data - i.e. the type of data is simply related to the type of product being sold with no functional or substantive effect on the system and apparatus (a configuring catalog copied from a manufacturer to a customer). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the above-mentioned manipulable parameters, or any parameters for that matter - in relation to a particular product - in the system of King/Geller, for the purpose of assembling a customized product.

In specific reference to claims 26 and 27, the system of King et al. and Geller does not explicitly provide that the data file is transmitted to the purchaser using an SGML format or a proprietary file format.

King discloses that information is transmitted to the customer using Electronic Data Interchange [Col 5, Line 25] (data file is an EDI format). It would have been

Art Unit: 3625

obvious to one of ordinary skill in the art to provide in the system of King/Geller for the transmission of data from the supplier to the customer using any number of formats.

The specific format being used, SGML or proprietary file format, would have been recognized by the skilled artisan as being one of numerous means appropriate for electronic data transfer. The applicant has not persuasively demonstrated that the particular methods suggested in the claims are critical or are anything more than one of the numerous methods that a skilled artisan would have found suitable for the purpose taught by King/Geller. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use either SGML or proprietary file format for transfer, similar to EDI used in the system of King/Geller, for the purpose of transferring a customized data file to the customer.

### ***Response to Arguments***

Applicant's arguments filed 7/7/2004 have been fully considered but they are not persuasive.

The Attorney argues (page 7 or Remarks) that nowhere in this discussion in the Geller article is there any mention of presenting a data file which allows a purchaser to configure products independent of a third party provided configuration tool, all as required by claim 1 for example.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections



Art Unit: 3625

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Examiner notes, it is inherent that a private catalog is accessed at the customer's computer (configuration of products independent of a third party provided configuration tool - the catalog is provided directly from the manufacturer and accessed at the customer's computer without third-party intervention). Furthermore Geller does discuss a method wherein a manufacturer might define a feature as an option. Each option typically is tied to a part number. During order entry, the end user selects one option from each feature group attached to the product being configured. The part number associated with the selected option is added to the configured product. Essentially a purchaser configures a product independent of a configuration tool; the purchaser merely selects options and transmits these options (data file) to the manufacturer.

The Attorney argues (page 8 or remarks) that King and the Geller Article, taken alone or in combination, do not teach or suggest a computer system which includes a processor, memory coupled to the processor, and a communication port configured to transmit a data file where the data file includes a catalog of configurable products *with at least one non-commodity product and service* to be received by a purchaser.

According to one embodiment of the instant application, the instant application defines a commodity as something that is pre-built or bundled such as a computer

Art Unit: 3625

system. The instant application uses the example of a “service” to describe something that is a non-commodity (page 13 of the original specification as filed). The Examiner notes, King discloses (column 3, lines 28-39) that the electronic catalog ordering system involves three principal players, the Suppliers, designated by block 100; the Customers/Requestors, designated by block 102, and the Public Database, designated by block 104. The Suppliers 100 load and maintain the catalog data of the products and/or services that they offer to the Customers 102. The Customers/Requestors 102 are those who purchase products and/or services from the catalogs. Per the applicants own definition the services as defined in King can be characterized as a “non-commodity” item.

The Attorney noted (page 9 of remarks), that the Applicant continues to reserve the right to later assert a request for documentary proof of any officially noticed facts set forth in the Office Action should Examiner not find Applicant’s claims allowable.

The Examiner notes, in order to adequately traverse an Official Notice, an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241. A general allegation that the claims define a patentable invention without any reference to the examiner’s assertion of official notice would be inadequate. In the instant application the applicant does not traverse the examiner’s assertion of

Art Unit: 3625

official notice, therefore the common knowledge or well-known in the art statements are taken to be admitted prior art.

These well-known statements include that configurators inherently comprise acknowledgement and notification of acceptable/unacceptable product configuration. It is established that configurators are widely known in the art of electronic shopping and catalog deployment.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG  
August 18, 2004



Jeffrey A. Smith  
Primary Examiner